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SEP 24 2004

OFFICE OF PETITIONS

In re Application of :
Michael Tobin, Timothy Richter, :
Hemant Mody, Michael Ronzello and : **DECISION REFUSING STATUS**
Dean Robarge : **UNDER 37 C.F.R. § 1.47(a)**
Application No. 10/708,448 :
Filed: March 4, 2004 :
Attorney Docket No. 41PR-133546 :
(GEN-0350) :
Title: METHOD AND APPARATUS FOR :
MAGNETICALLY TRIPPING CIRCUIT :
BREAKERS :

This is in response to the "PETITION UNDER 37 CFR 1.47(a) IN LIEU OF INVENTOR'S SIGNATURE," filed August 2, 2004.

The petition is **DISMISSED**.

Rule 47 applicants are given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on March 4, 2004, without a declaration executed by all of the joint inventors, except inventors Hemant Moody and Michael Ronzello. Accordingly, on May 21, 2004, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring the signatures of those inventors on a declaration and the surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed a declaration with the signature of inventor Ronzello; the surcharge under § 1.16(e); and the instant petition under § 1.47(a). This response was made timely by an accompanying petition for extension of time within the first month. Applicants assert that status under § 1.47(a) is proper because inventor Mody refuses to join in the application. In support thereof, applicants submitted the declaration of attorney David Arnold.

A grantable petition under 37 CFR § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirements (1) and (2).

As to requirement (1), petitioner has not shown that inventor Mody has refused to join in the application as required by § 1.47. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). Petitioners have not provided evidence that the application papers (specification, including claims, drawings, and oath or declaration) were all presented to inventor Mody for his signature. The declaration of attorney David Arnold indicates that only the Declaration and Assignment were presented to inventor Mody for signature.

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Mody (or to his attorney) and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

As to requirement (2), the declaration does not appear to include a proper citizenship for inventor Mody. His citizenship is stated as "Indian." Pursuant to 35 U.S.C. 115, each inventor shall state of what country he is a citizen. As citizenship is a statutory requirement, this requirement cannot be waived.

Further correspondence with respect to this decision should be addressed as follows:

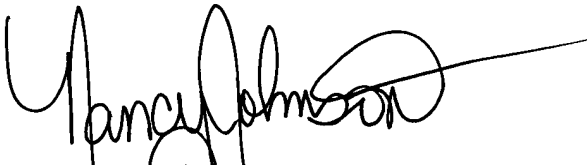
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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309 (or effective September 28, 2004 at (571) 272-3219).



Nancy Johnson
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